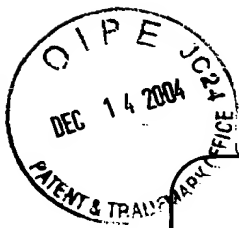


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PTO/SB/21 (05-03)

Approved for use through 04/30/2003. OMB 0651-0031

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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/882,523
	Filing Date	June 15, 2001
	First Named Inventor	Marek Minarik
	Art Unit	1713
	Examiner Name	Ling Siu Choi
Total Number of Pages in This Submission	Attorney Docket Number	MLD-044

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input checked="" type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <div style="text-align: center;">return post card</div>
Remarks  No fee is required (no amendment to claims).		

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Date	December 9, 2004

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Typed or printed name	Merle P. Garcia		
Signature	<i>Merle P. Garcia</i>	Date	December 9, 2004

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Response Under 37 C.F.R. 1.116  
Expedited Procedure  
Examining Group A.U. 1713  
1059 O.G. 19

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Marek Minarik et al.	PATENT APPLICATION
Serial No.:	09/882,523	Group Art Unit: 1713
Filed:	June 15, 2001	Examiner: L. S. Choi
For:	ELECTROPHORESIS SEPARATION MEDIA AND METHODS	

Amendment After Final Rejection

Mail Stop AF  
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P.O. Box 1450  
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Sir:

In response to the Office action mailed September 9, 2004 the applicants respectfully request reconsideration in light of the following remarks.

Section 102

As with the previous Office action the sole issue is whether the applicants' claims are anticipated by any one of the three cited references. A review of the law and the references warrant review of this rejection.

A claim is anticipated only if each and every element as set forth in the claim is found in a single cited art reference. See *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete

detail as is contained in the claim. See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Cited References Do Not Anticipate under the Strict Identity Rule

This test for anticipation under 35 USC §102(b) is a strict identity test. The Federal Circuit has repeatedly emphasized that a claim is only anticipated if every one of the claimed elements is identically set forth in a single reference. See *Gechter V. Davidson*, 43 USPQ2d 1032, 1032 (Fed. Cir. 1997); *Davis v. Loesch*, 27 USPQ2d 1440 (Fed. Cir. 1993).

Again, the applicants request reconsideration of this rejection given that one claimed element, non-entangled polyvinylpyrrolidone, is simply not taught in the cited references.

In the prior response it was noted that Barry et al never specifically refer to non-entangled PVP. Further the present record shows that the disclosed weight and concentration is outside the range of non-entangled PVP. The method of use of PVP in this reference is not consistent with the properties of non-entangled PVP. Given that these deficiencies are not addressed in the Office response, reconsideration of the rejection is required.

With respect to Barry et al., the sole argument disclosed by the Office action is that "the entanglement threshold also depends on properties of the solvent other than concentration". However nothing is cited to establish this as a fact. This alone warrants withdrawing this rejection.

Under the strict identity requirement of the law, the actual claimed step must be found in the cited reference. Thus to meet the anticipated standard the cited reference must specifically and explicitly disclose a non-entangled media. This test has not been met. There has been no citation from

Barry et al. establishing the use of non-entangled polyvinylpyrrolidone as a separation media as claimed. Without this showing, the mere possibility under some postulated circumstance (this is not found in the cited reference) that the claimed element would be achieved is far short of the legal standard. The only way Barry et al could anticipate the claim is if the solvent proposed in the Office action were actually disclosed in a clear teaching of a use of PVP as a separation media. Instead, every indication from the reference, not only including the stated concentration noted in the previous response, but also the injection method disclosed in this cited reference indicates that the media of the cited reference is not the non-entangled PVP claimed by the applicant. This is also true of the Zhu et al. reference as noted in the prior response. The Office action has cited nothing from this reference that teaches what is claimed.

With respect to the third cited reference, Madabhushi et al., the Office action states that the authors of this reference "do disclose the method the use the non-entangled polyvinylpyrrolidone, wherein the polyvinylpyrrolidone adsorbed on the silica surface, which is not excluded from the present claims". However the applicants again note that the legal standard is not that the claims must exclude what is in a cited reference. Instead the standard compels that the reference must teach every limitation of a claim. This section of the Office action states that the cited reference teaches PVP as an agent adsorbed onto the capillary. This would then preclude use of the PVP as a separation media, as claimed by the applicant. In addition to the lack of teaching non-entangled PVP, this provides a second reason to reconsider this rejection based on this reference.

As noted in the previous response, the use of non-entangled separation media is an important feature of the invention. The low viscosity allows simplified loading of the media and is adaptable to multiple injection separation. The

cited references fall far short of providing an enabling teaching of the applicants claimed subject matter. For this reason reconsideration of this rejection would be proper.

Dependent claims

The applicants further note that a number of the dependent claims also specifically limit the claimed method. These are not found in the cited references. The Office action states "the step of loading capillary using gas pressure (claim 4) or the step of repeating injection and separation (claim 8) are obvious to one of ordinary skill in the art at the time the invention was made". However this is an insufficient basis for the anticipation rejection of the applicants' claims.

First, the cited law establishes that the anticipation of claims may not be predicated on an assertion of what is obvious. The law states that an anticipation rejection is only proper if the elements as claimed are found within a cited reference identically as claimed. Since nothing has been cited in these references to anticipate the dependent claims, no prima facie case for the rejection of claims 2-17 has been established and these claims should be allowed.

Second, this rejection is predicated on a mischaracterization of the applicants' claims. A review of the actual claims, in light of the cited reference, indicates reconsideration of the rejection is proper.

Claim 4 not only requires gas pressure loading of the capillary tube but also further specifies, "said gas pressure not greater than 100 psi". According to the specific identity test, the cited reference must teach what is specifically claimed. As noted in the previous response, nothing from the cited references teach this claimed element of loading using a specific pressure range. The reason the references fail to teach this is not trivial. The reason the

references fail to teach loading at this low pressure is because the separation media in the disclosed references is an entangled polymer or is otherwise too viscous to load under the claimed pressure. Given this fact, claim 4 is not found in the cited references and thus is allowable.

The same is also true of claim 8. The Office action has again mischaracterized the claim, which requires that multiple samples be injected after intervals of electrophoretic separation, followed by continuous detection. This is not the same as "repeating injection and separation". Further, as noted in the previous response and in the application, this is a rather specific method not in widespread use. The strictures of patent law state that anticipation is only proper if every element of the claim, even of a dependent claim, is found in the four corners of a cited reference. Since nothing from any of the three references has been cited to disclose the specific method of claim 8 (or any of claims 2-17) the claims have not been anticipated and a withdrawing of this rejection is proper.

#### Conclusion

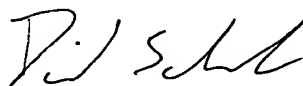
In light of the foregoing remarks, the present rejection should be reconsidered. A notice of allowance is earnestly solicited. If the Examiner has any questions in relation to this matter, please contact the undersigned attorney at (408) 297-9733 between 9 AM and 5PM Pacific Time.

Respectfully submitted,

#### CERTIFICATE OF MAILING

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Signed: Merle P. Garcia  
Typed Name: Merle P. Garcia  
Date: December 9, 2004



David Schneck

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